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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			POULOS, SANDRA K	
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			1714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/639,613	<b>Applicant(s)</b> LI ET AL.	
	<b>Examiner</b> Sandra K. Poulos	<b>Art Unit</b> 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3-20, and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-20 and 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. All outstanding rejections and objections except for those described below are overcome by applicant's amendment filed 4/11/06.
2. The new grounds of rejection set forth below are necessitated by applicant's amendment filed 4/11/06. In particular, claim 1 has been amended to be further limited by the phrase "an emulsion lubricant composition comprising an oil phase and an aqueous phase, the oil phase comprising silicone" wherein the silicone was not present in any of the claims as previously presented. The limitation with respect to the "emulsion lubricant" was recited in a dependent claim but is now present in the independent claim and thus the other claims have this new limitation, wherein they previously did not. Thus the following action is properly made **FINAL**.
3. \*The examiner does not find support for the limitation "an emulsion lubricant" in the parent application, thus the effective filing date for all claims of the current application is considered to be 8/11/2003.

### ***Claim Objections***

Claims 10 and 11 are objected to because of the following informalities: They depend on a canceled claim. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**There are six (6) obvious double patenting rejection set forth below over the following (1) US Pat 6,509,302; (2) US Pat 6,673,753; (3) US Pat 6,780,823; (4) US Pat 6,806,240; (5) US Pat 6,809,068; (6) Appl 10/614474. A Table summarizing the following rejections is included on page 15 of this Office action.**

*Double Patenting (1)*

4. Claims 1, 5-8, 12-14, 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32-69 of U.S. Patent No. 6,509,302.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The claims of US 6,509,302 a method of lubricating the interface between the container and a moving conveyor surface, the method comprising: (a) forming a coating of a liquid lubricant composition on a container contact surface of a moving conveyor, the lubricant composition comprising a stable dispersion of a first liquid phase and a second liquid phase resulting in a dispersion of the first phase as droplets in a continuous second liquid phase, the resulting dispersion being transparent; and (b) moving the container on the conveyor surface in order to transport the container from a first location to a second location (claim 32). The mixture is a microemulsion (claim 61). The oleophilic material comprises a dispersion of a silicone composition in an aqueous medium (claim 51, 59). Although the claims are silent with respect to foam, the specification discloses that a thin lubricating coating of the dispersed or microemulsion lubricant on the conveyor provides adequate lubrication to the conveyor system but ensures that the lubricant cannot generate high foam, does not flow from the conveyor

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surface (col 5, lines 23-27). Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). Thus it would have been obvious that the lubricant lacked foam.

5. Claims 1, 5-8, 12-14, 74 are directed to an invention not patentably distinct from claims 32-69 of commonly assigned US 6,509,302. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 4 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US 6,509,302, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

6. Claims 1, 5-8, 12-14, 74 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,509,302.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of

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invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

For an explanation of the rejection, see paragraph 4 above.

#### *Double Patenting (2)*

7. Claims 1, 3-20, 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-61 of U.S. Patent No. 6,673,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The claims of US 6,673,753 disclose a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, the method comprising: (a) forming a continuous thin film of a liquid lubricant composition on a container contact surface of a conveyor; and (b) moving a container on the conveyor surface in order to transport the container from a first location to a second location. (claim 36). The lubricant comprises an emulsion (claim 37). Although the method claims of 37-61 are silent with respect to a silicone, the lubricant claims, in particular claim 66 discloses that a silicone material is part of the lubricant. Thus it would have been obvious that to use a silicone in the composition described in the method claims.

8. Claims 1, 3-20, 74 are directed to an invention not patentably distinct from claims 37-61 of commonly assigned US 6,673,753. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 7 above.

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The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,673,753, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

9. Claims 1, 3-20, 74 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,673,753.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

For an explanation of the rejection, see paragraph 7 above.

#### *Double Patenting (3)*

10. Claims 1, 3-7, 12-17, 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,780,823.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The claims of US 6,780,823 disclose a method of lubricating the interface between a container and a moving conveyor surface comprising the steps of: (a) applying a film of an aqueous lubricant composition comprising about 5 to 50 wt % of an aqueous phase to a container contact surface of a conveyor; and (b) moving a container on the conveyor surface to transport the container from a first location to a second location; wherein the lubricant composition is applied in an amount of about  $2 \times 10^{-4}$  to 0.05 gms-in<sup>2</sup> of conveyor surface and wherein the film has a thickness of less than about 5 mm. The lubricant composition comprises an emulsion of an organic phase and an aqueous phase (claims 2). Claim 11 discloses silicone oil in the organic phase. The difference between the claims of US 6,780,823 and the current claims is that the independent claim of 6,780,823 does not contain the emulsion and silicone limitations, instead they are found in the dependent claims. However, it would have been obvious to one of ordinary skill in the art to incorporate the limitations of the dependent claims into the independent claim, and thus obtain an emulsion lubricant with an oil phase containing silicone oil.

Although the claims are silent with respect to foam, the specification discloses that a thin lubricating film of the lubricant on the conveyor provides adequate lubrication to the conveyor system but ensures that the lubricant cannot foam, does not flow from the conveyor surface (col 3, lines 8-13). Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). Thus it would have been obvious that the lubricant lacked foam.



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11. Claims 1, 3-7, 12-17, 74 are directed to an invention not patentably distinct from claims 1-21 of commonly assigned US 6,780,823. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 10 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,780,823, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

12. Claims 1, 3-7, 12-17, 74 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,780,823.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For an explanation of the rejection, see paragraph 10 above.

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*Double Patenting (4)*

13. Claims 1, 3-20, 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8-33 of U.S. Patent No. 6,806,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The claims of US 6,806,240 disclose a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, the method comprising: (a) forming a continuous thin film of a liquid lubricant composition on a container contact surface of a conveyor; and (b) moving a container on the conveyor surface in order to transport the container from a first location to a second location. The liquid lubricant comprises an emulsion of an organic phase and an aqueous phase. The claims are silent with respect to use of silicone in the oil. Silicone lubricant appears numerous times in the specification (col 5, line 66; col 7, line 61; col 10, lines 50-51; col 11, lines 10-12, 19-67; col 12, lines 1-7). Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). Thus, it would have been obvious to one of ordinary skill in the art to use the silicone discussed in the specification in the claimed method since it is clearly intended by the disclosure.

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14. Claims 1, 3-20, 74 are directed to an invention not patentably distinct from claims 8-33 of commonly assigned US 6,806,240. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 13 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,806,240, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

15. Claims 1, 3-20, 74 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,806,240.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

For an explanation of the rejection, see paragraph 13 above.

#### *Double Patenting (5)*

16. Claims 1, 3, 5, 15-16, 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,809,068.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The claims of US 6,809,068 disclose a method of lubricating the interface between a container and a moving conveyor surface to reduce frictional resistance between the conveyor and the containers transported thereon, the method comprising applying, by direct contact with no dilution of a lubricant concentrate, an effective amount of a liquid lubricant composition between a container and a contact surface of the moving conveyor to reduce frictional resistance between the conveyor and the containers transported thereon, the lubricant comprising an aqueous solution comprising at least one weight percent of a polysiloxane composition based on the liquid lubricant. The lubricant is present in the form of a gel, emulsion, paste or dispersion of a liquid lubricant in an aqueous phase (claim 9). Substantially no foam is formed from the lubricant during the conveying of the containers on the conveyors (claim 22).

The difference between the claims of US 6,809,068 and the current claims is that the independent claim of US 6,809,068 does not contain the emulsion and foam limitations, instead they are found in the dependent claims. However, it would have been obvious to one of ordinary skill in the art to incorporate the limitations of the dependent claims into the independent claim, and thus obtain an emulsion lubricant that lacks foam. Claims 11 discloses silicone oil in the organic phase. The difference between the claims of US 6,780,823 and the current claims is that the independent claim of 6,780,823 does not contain the emulsion and silicone limitations, instead they are found in the dependent claims. However, it would have been obvious to one of ordinary skill in the art to incorporate the limitations of the dependent claims into the independent claim, and thus obtain an emulsion lubricant with an oil phase containing silicone oil.

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17. Claims 1, 3, 5, 15-16, 74 are directed to an invention not patentably distinct from claims 1-36 of commonly assigned 6,809,068. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 16 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,809,068, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

18. Claims 1, 3, 5, 15-16, 74 are rejected under 35 U.S.C. 103(a) as being obvious over US 6,809,068.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

For an explanation of the rejection, see paragraph 16 above.

#### *Double Patenting (6)*

19. Claims 1, 3-20, 74 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-110 of copending Application No.

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10/614,474 (US 2004/0058829). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The claims of 10/614,474 disclose a method of lubricating the interface between a container and a moving conveyor surface, in the substantial absence of foamed lubricant and lubricant runoff, the method comprising: (a) forming a continuous thin film of a liquid lubricant composition on a container contact surface of a conveyor; and (b) moving a container on the conveyor surface in order to transport the container from a first location to a second location. The liquid lubricant comprises an emulsion of an organic phase and an aqueous phase. Claims 85, 98, 101, 103, 104, 112-114 and the specification discloses silicone contained in the lubricant; however silicone is not in the independent claim.

Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). It would have been obvious to one of ordinary skill in the art to incorporate the silicone of the dependent claims into the independent claim 36 or to incorporate the silicone as discussed in the specification because it is clearly intended to be the preferable lubricant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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20. Claims 1, 3-20, 74 are directed to an invention not patentably distinct from claims 36-110 of commonly assigned 10/614,474. Specifically, although the conflicting claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 19 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 10/614,474, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

21. Claims 1, 3-20, 74 are rejected under 35 U.S.C. 103(a) as being obvious over US 2004/0058829.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For an explanation of the rejection, see paragraph 19 above.

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The following Table summarizes the above obvious double patenting rejections:

	Document	Claims rejected	Unpatentable over claims
1	6,509,302	1,5-8,12-14,74	32-69
2	6,673,753	1,3-20,74	37-61
3	6,780,823	1,3-7,12-14,74	1-21
4	6,806,240	1,3-20,74	8-33
5	6,809,608	1,3,5,15-16,74	1-36
6	10/614,474	1,3-20,74	36-110

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

22. Claims 1, 3-20, 74 are rejected under 35 U.S.C. 102(b)\* as being anticipated by Li et al (US 6,427,826).

Li '826 discloses a lubricant for a conveyor surface that is in the form of an aqueous oil emulsion (col 3, lines 1-10) and the lubricant does not foam and does not flow from the conveyor surface (col 3, lines 1-3; claim 70). Examples of the synthetic oils include silicones such as silicone surfactants (col 4, lines 27-31, 56-58; col 5, lines 58-59; examples 23-24; claim 25, 62). The aqueous phase is 5-50% (col 4, lines 13-17). The lubricant layer is preferably  $2 \times 10^{-4}$  to 0.05 gms-in<sup>2</sup> and is at a thickness of less than 3 mm (col 2, lines 62-67). The contact with the pentaloid base is minimized (col 3, lines 22-23), and there is no change in shape of the container (col 3, lines 30-32). The emulsion can be either stable or unstable to phase separations (col 3, lines 12-15, claims 10-11). The desirable coefficient of friction of the conveyor lubricant is about 0.1 to 0.14 (col 3, lines 33-34). The lubricant is applied using a brush or spray applicator (claims 15-16, 54-55). The container is filled with carbonated beverage and



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maintained under pressure (claims 17, 56). The continuous thin film of the lubricant is placed on the surface of the moving conveyor leaving an unlubricated margin on the conveyor edge (claims 18, 57), the width of the lubricated area on the conveyor is about 3 to 150 inches (claims 19, 58), and the unlubricated margins is greater than about 0.5 inches (claim 20).

Thus, Li '826 anticipates the cited claims.

23. Claims 1,5-8,12-14,74 are rejected under 35 U.S.C. 102(e)\* as being anticipated by 6,509,302

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the rejection in paragraphs 4-6 above.

24. Claims 1,3-20,74 are rejected under 35 U.S.C. 102(e)\* as being anticipated by 6,673,753.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the rejection in paragraphs 7-9 above.

25. Claims 1,3-7,12-14,74 are rejected under 35 U.S.C. 102(e)\* as being anticipated by 6,780,823.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the rejection in paragraphs 10-12 above.

26. Claims 1,3-20,74 are rejected under 35 U.S.C. 102(e)\* as being anticipated by 6,806,240.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the rejection in paragraphs 13-15 above.

27. Claims 1,3,5,15-16,74 are rejected under 35 U.S.C. 102(e)\* as being anticipated by 6,809,608.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the rejection in paragraphs 16-18 above.

28. Claims 1,3-20,74 are rejected under 35 U.S.C. 102(e)\* as being anticipated by 2004/0058829.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See the rejection in paragraphs 19-21 above.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection set forth above.

***Conclusion***

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 7:30-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Sip*

Sandra K. Poulos

*Vasu Jagannathan*  
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